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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,106	10/12/2001	Neal A. Hammond	461	1724

7590

08/13/2003

Robert Charles Hill
235 Montgomery Street #821
San Francisco, CA 94104

EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,106

Applicant(s)

HAMMOND, NEAL A.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-12 is/are rejected.
- 7) ☒ Claim(s) 6,7,13 and 14 is/are objected to.
- 8) ☒ Claim(s) 23-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Election/Restrictions***

Newly submitted claims 23-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention of claims 1-14 and the invention of claims 23-25 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process may be used with other grain or cereal starting materials to produce different extruded hydrolyzed products.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 11-12 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Rejections maintained:

Again, the term “flours”, in claim 8, lacks a clear antecedent basis, as only a single “rice flour ingredient” had been stated previously in claim 1.

The following phrases are indefinite, as they are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

- “substantially less” – claim 8.
- “bland, neutral taste” – claim 11.

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- “adjust” – claim 12. It is unclear if this is an alteration of the pH to a more acidic or more basic level.

Claim 12 is indefinite, as it is unclear as to how the step of a second extrusion would serve to inactivate the enzymes and “adjust the pH” of the product, yet presumably, the initial extrusion would not provide this effect.

New rejection:

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The phrase “hydrolyzed rice flour depends on enzyme activity” is indefinite. The meaning of this phrase is unclear with respect to the claimed invention, primarily due to the term “depends.” It is unclear as to what properties, factors and/or events regarding the hydrolyzed rice flour, “depend” on enzyme activity. The metes and bounds of the claimed invention are not set forth, as it is unclear as to how the hydrolyzed rice flour “depends” on enzyme activity, and to what degree. This appears to be not only a term of degree, but may also be interpreted as an intended optional condition; however, as the rice flour is already indicated as hydrolyzed, it is unclear as to how this may be so.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami et al. The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed May 18, 2003 have been fully considered but they are not persuasive. At page 4 of the response, applicant states that the products of the reference are used for different end purposes (“potages, stews, curries, etc.”) than the instantly-claimed products, which are used as a fat substitute. Applicant also states that “the dehydration and rehydration steps by Minami affect the finished

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product which makes it useless as a fat replacer.” This is not deemed persuasive for the reasons of record. Simply put, applicant’s claims broadly encompass the method of Minami et al.

A recitation or traversal showing of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The method of producing the extruded product of the reference meets the instant claim limitations. Simply because Minami et al. further processes the product for use in other food systems, in no way indicates that the extruded product of the referenced method would be different from that of the instant claims. Further, it is important to note that the claims under examination are directed to a method, not a product, and one that “comprises the steps”, which is not a closed system. Still, if applicant’s claims were recited as a closed system (such as “consisting of the steps”), then the argument regarding the use of the end product would not be relevant.

Claims 1-4, 8-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Reddy et al. The reference and rejection are incorporated as cited in a previous Office action.

Applicant’s arguments filed May 18, 2003 have been fully considered but they are not persuasive. At page 4 of the response, applicant states that the instantly-claimed method “to a food-making process for a fat substitute... is not even close to the biochemical media system for reducing pollution” of the Reddy reference. Applicant states that “Reddy certainly does not use his finished product as a replacement for fat.”

This is not deemed persuasive for the reasons of record. Simply put, applicant’s claims broadly encompass the method of Reddy et al. While the reference may focus on utilizing the end product of the method for purposes different from that of applicant’s, this is irrelevant to the actual method steps claimed. A recitation or traversal showing of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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The method of producing the extruded product of the reference meets the instant claim limitations. Simply because Reddy et al. further processes the product for use in other food systems, in no way indicates that the extruded product of the referenced method would be different from that of the instant claims. Further, it is important to note that the claims under examination are directed to a method, not a product, and one that "comprises the steps", which is not a closed system. Still, if applicant's claims were recited as a closed system (such as "consisting of the steps"), then the argument regarding the use of the end product would not be relevant.

Conclusion

Claims 6-7 and 12-14 are free of the prior art of record. Claims 6-7 and 13-14 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



**KEITH HENDRICKS
PRIMARY EXAMINER**